

REMARKS

This paper is being submitted in response to the Final Office Action ("Action") mailed on August 6, 2009 and Advisory Action mailed October 28, 2009. Claims 3-9 are pending. Claims 3-9 are rejected. Claims 3, 7, and 8 are amended herein. New claims 10-17 have been added. Applicant respectfully requests reconsideration of claims 3-17 in view of the foregoing amendments and the following remarks.

An amendment to the specification was included in the response filed October 6, 2009. The Advisory Action indicated that the amendment has been entered. The amendment to the specification is not repeated herein. However, for clarity the claims as listed herein show amendments relative to the claims as rejected in the August 6, 2009 Final Office Action.

I. CLAIM REJECTIONS

35 USC § 103 (a) Rejections

Claims 3-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gelardi et al (US 2003/0106814) in view of Petermann (DE 20008218). Applicant respectfully traverses the rejection.

In considering a §103(a) rejection, the question is whether there is any reason why the references could or would be combined. Just because a combination is possible does not mean that any motivation is present to make the combination. The unsuitability of an individual reference or its apparent irrelevance to the problem to be solved are pertinent to whether the combination would have been obvious.

Examiner states that Petermann teaches that it is desirable to create a binding structure which allows a problem-free and unhindered opening of the book in addition to the planar elements

or pages lying flat when opened. However, Gelardi does not show a particular need for “problem-free and unhindered opening of the book, in addition to the planar elements lying flat when opened.” Gelardi’s having only one cover attached to the stack already allows for easy opening of the book.

In the Advisory Action, Examiner admits that it is unclear whether Petermann explicitly states a specific purpose of the “3-mm wide margin.” Applicant respectfully asks why one skilled in the art would combine this unexplained element with Gelardi. A possible use for the 3-mm wide margin is that Petermann’s 3-mm margins, upon opening the book, allow some flexing of the cover in the area of the spine, so that the book opens easier. However, this does not appear to be a difficulty encountered by Gelardi, whose stack is only attached to one cover. Therefore Applicant disagrees that it would have been obvious to combine Petermann with Gelardi.

Furthermore, a rejection based on obviousness requires that there be a reasonable expectation of success for the combination of references (*MPEP 2143. 02*) Applicant submits that there is not a reasonable expectation of success when Petermann does not explain the function of the 3-mm margin, and when the Gelardi and Petermann structures differ significantly (Gelardi’s cover being attached only at the back, and Petermann’s attached at both front and back.)

At least for the forgoing reasons, Applicant respectfully requests the 103(a) rejection of claims 3-9 to be reconsidered and withdrawn.

II. NEW CLAIMS

New claims 10-11 are added herein which recite relative dimensions of the strip section and trays. These claims are supported by Applicant’s Figures. New claims 12-17 are also added herein which are supported by Applicant’s Figures 3-5 and paragraphs 17 -19 of the specification.

CONCLUSION

All remaining claims are believed to be in condition for allowance, and an early notice thereof is respectfully requested. Should the Examiner determine that additional issues exist which might be resolved by a telephone conference, they are respectfully invited to contact the Applicant's undersigned representative.

The Director is hereby authorized to charge any additional fees or underpayments of fees under 37 C.F.R. §§ 1.16 and 1.17, or to credit any overpayments, to Deposit Account Number 13-2500. Applicant is a large entity.

Respectfully Submitted,

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